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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/892,397	06/27/2001	Jennifer Q. Trelewicz	BLD920010007US1	2162
23334	7590	09/08/2004	EXAMINER	
FLEIT, KAIN, GIBBONS, GUTMAN, BONGINI & BIANCO P.L. ONE BOCA COMMERCE CENTER 551 NORTHWEST 77TH STREET, SUITE 111 BOCA RATON, FL 33487			BADERMAN, SCOTT T	
			ART UNIT	PAPER NUMBER
			2113	
DATE MAILED: 09/08/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/892,397	Applicant(s) TRELEWICZ ET AL.	
	Examiner Scott T Baderman	Art Unit 2113	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 June 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,5,8-10,12,14-22 and 26 is/are rejected.
- 7) ☒ Claim(s) 2-4,6,7,11,13 and 23-25 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) • | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>6/27/01</u> . • | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Allowable Subject Matter

1. Claims 2-4, 6, 7, 11, 13 and 23-25 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 14-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As in claim 14, lines 8-10 it states, "A triggering event detector...for printing print data..." It is indefinite as to how the "triggering event detector" can print data.

As in claim 18, lines 11-13 it states, "A triggering event detector...for printing print data..." It is indefinite as to how the "triggering event detector" can print data.

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As in claims 15-17 and 19-21, these claims are rejected due to the fact that they are dependent from claims 14 and 18, respectively.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1, 5, 8-10, 12, 22 and 26 are rejected under 35 U.S.C. 102(e) as being anticipated by Horigane (2001/0006585).

As in claims 1 and 22, Horigane discloses a method for triggering an embedding algorithm in response to a triggering event (user input) (Figure 2, page 3: paragraph 44, page 4: paragraphs 57-59), receiving print data (Figure 2, page 3: paragraphs 43-45, page 4: paragraphs 57-59), reading printer configuration data (e.g., print date information, number-of-page information, etc.) (page 1: paragraphs 8 and 13, page 4: paragraphs 57-59), encoding the configuration data (page 4: paragraphs 56-57), embedding the encoded configuration data into the print data (page 4: paragraph 58), sending the print data to a printhead (within printer) (page

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4: paragraphs 58-62), and printing the print data as a visible image comprising the embedded encoded configuration data (Figure 7, page 1: paragraph 8, page 5: paragraph 70).

As in claims 5 and 26, Horigane discloses wherein the triggering step comprises initiating a triggering event by detecting the print data originates from a predetermined source (e.g., the application data the user wishes to print) (page 1: paragraph 7, page 3: paragraph 44-46).

As in claim 8, Horigane discloses wherein the triggering step comprises initiating a triggering event by recognizing a set parameter to embed data in the print data (i.e., the user input acts as a set parameter) (page 3: paragraph 44).

As in claim 9, Horigane discloses wherein the triggering step comprises initiating a triggering event by detecting the activation of a button (page 5: paragraph 70).

As in claim 10, Horigane discloses wherein the activation of the button comprises a detection of activation of a physical button on the printer device (page 5: paragraph 70).

As in claim 12, Horigane discloses scanning the printed data to provide scanned data, analyzing the scanned data to recognize embedded data, and providing encoded data corresponding to the recognized embedded data (Figure 7, page 5: paragraph 72).

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6. Claim 14-21 are rejected under 35 U.S.C. 102(e) as being anticipated by Wasilewski (2002/0120944).

As in claim 14, Wasilewski discloses an apparatus that comprises a data embedding application (within the operating software) (Abstract, page 5: paragraph 54), a controller/processor unit communicatively coupled to the data embedding application (Figure 6, element 615), a data memory communicatively coupled to the controller/processor unit (Figure 6, element 620), a print engine communicatively coupled to the controller/processor unit (Figure 6, element 635), a printhead communicatively coupled to the print engine (within the printer) (Figure 6, element 635), and a trigger event detector, communicatively coupled to the data embedding application and the controller/processor unit, for printing print data comprising embedded data in response to detecting a trigger event (command) at the apparatus (Figure 6, Abstract, page 5: paragraphs 52-54).

As in claim 15, Wasilewski discloses providing a self-analysis module communicatively coupled to the controller/processor unit, wherein the self-analysis module provides a triggering event (i.e., the user and remote control unit are interpreted as the self-analysis module since they produce a trigger event) (Figure 6, Abstract, page 4: paragraph 50).

As in claim 16, Wasilewski discloses providing a supply monitoring module communicatively coupled to the controller/processor unit, wherein the supply monitoring module provides a triggering event (i.e., the user and remote control unit are interpreted as the supply

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monitoring module since they produce a trigger event) (Figure 6, Abstract, page 4: paragraph 50).

As in claim 17, Wasilewski discloses a configuration database including configuration data for the triggering event detector and for the data embedding application (page 5: paragraph 52), and a document queue (i.e., printers typically have document queues within them).

As in claim 18, Wasilewski discloses an apparatus that comprises at least one networked device (Figure 1), a network interface, communicatively coupled to the at least one networked device (Figure 1), a data embedding application (within the operating software) (Abstract, page 5: paragraph 54), a controller/processor unit communicatively coupled to the data embedding application and to the network interface (Figure 6, element 615), a data memory communicatively coupled to the controller/processor unit (Figure 6, element 620), a print engine communicatively coupled to the controller/processor unit (Figure 6, element 635), a printhead communicatively coupled to the print engine (within the printer) (Figure 6, element 635), and a trigger event detector, communicatively coupled to the data embedding application and the controller/processor unit, for printing print data comprising embedded data in response to detecting a trigger event (command) at the apparatus (Figure 6, Abstract, page 5: paragraphs 52-54).

As in claim 19, Wasilewski discloses providing a document source detection module communicatively coupled to the controller/processor unit, wherein the document source

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detection module provides a triggering event (i.e., the user and remote control unit are interpreted as the document source detection module since they produce a trigger event) (Figure 6, Abstract, page 4: paragraph 50).

As in claim 20, Wasilewski discloses providing a supply monitoring module communicatively coupled to the controller/processor unit, wherein the supply monitoring module provides a triggering event (i.e., the user and remote control unit are interpreted as the supply monitoring module since they produce a trigger event) (Figure 6, Abstract, page 4: paragraph 50).

As in claim 21, Wasilewski discloses a configuration database including configuration data for the triggering event detector and for the data embedding application (page 5: paragraph 52), and a document queue for storing documents received from the at least one networked device (i.e., printers typically have document queues within them) (Figures 1 and 6, Abstract).

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

See Form PTO-892.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott T Baderman whose telephone number is (703) 305-4644. The examiner can normally be reached on Monday-Friday, 6:45 AM-4:15 PM, first Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Beausoliel can be reached on (703) 305-9713. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Scott T Baderman
Primary Examiner
Art Unit 2113

STB